REMARKS

Claims 1-63 are pending in the application.

Claims 1-63 stand rejected.

Claims 36-49 are cancelled.

Rejection of Claims under 35 U.S.C. §101

Claims 50-63 stand rejected under 35 U.S.C. § 101 as being purportedly directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

Paragraph 1 of the Office Action states that claim 50 is not directed to a process. Applicants respectfully disagree and note that paragraph 2 of the Office Action directly contradicts this statement and explicitly admits that "claim 50 recites a process."

Paragraph 2 of the Office Action relies upon the well-publicized Federal Circuit opinion in *Bilski. In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008). Applicants respectfully note that since the Office Action was issued, the Supreme Court has issued an opinion in Bilski which declines to adopt the Federal Circuits limitations on the meaning of 35 USC § 101. *See Bilski v. Kappos,* (Supreme Court 2010) (08-964).Thus, Applicants respectfully submit that this rejection based on lower court precedent is no longer the law, in light of the recent Supreme Court decision.

Claims 1-18, 21-36 and 38-49 stand rejected under 35 U.S.C. § 101 because these dependent claims purportedly contain a combination of two or more statutory classes, namely a system and a process/method, and in some cases also an article (a processor) and a computer readable storage medium. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the claims are clearly and explicitly directed to a system, and not a method. While the claims recite that the system comprises both a processor and a computer readable storage medium, Applicants respectfully submit that this fact fails to provide any statutory basis for rejecting the claims. That is, there is no statutory prohibition against a system claim that includes both a processor and a computer readable storage medium.

For at least the foregoing reasons, Applicants respectfully request the Examiner's reconsideration and withdrawal of the rejections to these claims and an indication of the allowability of same.

Rejection of Claims under 35 U.S.C. §112 (alleged lack of utility)

Claims 1-63 stand rejected under 35 U.S.C. §112. Applicants respectfully traverse this rejection.

Paragraphs 4-9 of the Office Action appear to allege that the claims are vague and indefinite. However, as noted in § 2173.04 of the MPEP, "breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph." Applicants respectfully submit that the meaning of the claim terms is clear to those of ordinary skill in the art in light of the written description provided.

Paragraphs 10-12 of the Office Action are directed to claims 36-46. While not conceding the appropriateness of these rejections, but in order to expedite prosecution, Applicants have cancelled these claims. Therefore, Applicants respectfully submit that these rejections are moot as to these claims.

For at least the foregoing reasons, Applicants respectfully request the Examiner's reconsideration and withdrawal of the rejections to these claims and an indication of the allowability of same.

Rejection of Claims under 35 U.S.C. §103

Claims 1-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Esposito (USPN 6,587,838) in view of Wiecha (USPN 5,870,717). Applicants respectfully traverse this rejection.

The Office Action states that Esposito teaches the claimed invention, save for construction of the software for processing complex customer inquiries and purchase orders. *See* Office Action, pp. 11-12. However, with regard to independent Claims 1, 19, 36 and 50, the cited portion of Esposito merely discloses a means of notifying a vendor of a customer's interest in a product. Furthermore, no specific citation, *e.g.*, page and line, to Wiecha is made at all with regard to the dependent claims, aside from a 6-line citation to Esposito purported to disclose the limitations of the claim language recited in nearly 60 claims. Applicants are left to conclude that these claims are rejected simply for depending on a rejected claim. The Office Action merely picks a few of the claims, states that certain of such terminology such as that used in the claims is known (a point that Applicants do not concede), and then goes on in an attempt to fabricate some manner of skill in the art by making the conclusory statement that such are obvious as such terminology is known to users of systems from Computer Associates, SAP, Baan and Oracle (once again, a point that Applicants do not concede).

Further, the Office Action admits that Esposito fails to teach the construction of the software for processing complex customer inquiries and purchase orders. *See* Office Action, p. 12. For example, nowhere in Esposito is there shown, taught or suggested the generation of a customer portal. The Office Action points to figures 1-7 of Esposito as purported teaching of a customer portal. Of these, Figure 5-7 show generic information entry screens, but the Office Action makes no effort to map these various screens to the elements recited with respect to a customer portal, such as, *e.g.*, a list of products and services associated with an account, a list of quotes associated with the account, a list of orders associated with the account, and a plurality of user-selectable options," as recited.

Moreover, nowhere is there shown, taught or suggested the invocation of a workflow process and, subsequently, a business service method, and so the performance

of a function associated with a selected option. This is the case because Esposito teaches a "...a system for providing real-time notification of purchaser requirements in a heterogeneous network environment ...." *See* Esposito, Abstract. Thus, Esposito is directed to conducting real-time electronic commerce, and is not equipped to deal with complex order processing, as in the claimed invention.

Wiecha is directed to a system for ordering items over a computer network using an electronic catalog. However, there is nothing taught by Wiecha that demonstrates anything more than simply a computer-based catalog system that allows a user to order items in the catalog electronically. This is just a system that enables an employee who needs an item which must be ordered from a supplier to select the item from an electronic catalog displayed on a personal computer and submit an order for approval and processing directly, bypassing both the normal paper approvals and the manual verification of the order by the organization's purchasing department.

By marked contrast, the claimed invention is directed, for example, to a method including the generation of a customer portal. Moreover, nowhere in the references is there shown, taught or suggested the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option. Thus, neither Esposito nor Wiecha, taken alone or in permissible combination, shows, teaches or suggests (or has reason to do so) the use of the claimed invocations to address a user's need to perform certain functions as recited in Applicants' claims.

In addition to the foregoing infirmities, this lack of invocations results from the fact that neither Esposito nor Wiecha, taken separately or in any permissible combination, has need or recognition of technology such as that provided by the claimed invention. That neither reference teaches such technology thus comes as no surprise. In Esposito, the chosen approach is preferred in order to provide real-time notification of purchaser requirements in a heterogeneous network environment, and so the use of the claimed technology goes unrecognized and unappreciated. Given that the method is achieved through the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option, such

functionality cannot be exercised in systems employing the design of Esposito. Wiecha fails to cure this infirmity of Esposito.

To wit, while Esposito may discuss a system which enables an employee who needs an item which must be ordered from a supplier to select the item from an electronic catalog displayed on a personal computer and submit an order for approval and processing, nothing is shown, taught or suggested with regard to the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option. This is at least for the reason that Esposito is concerned with avoiding the traditional use of paper documents and used for purchasing department approval. Given that Wiecha has no need of the claimed technology in achieving this end, one of skill in the art would not look to Wiecha's disclosure for such teachings. In fact, given that Wiecha fails to demonstrate any sort of need for such technology, one would not expect one of skill in the art to look anywhere therefore. Thus, Wiecha provides neither a way to modify Esposito, nor does either reference demonstrate any sort of a need for such technology.

Thus, the Office Action does not establish the presence of these limitations in Esposito or Wiecha, taken alone or in permissible combination. As the Examiner appreciates, the burden is of supporting a case of obviousness lies with the Office, including whether the prior art references teach or suggest all of the claim limitations. *See* MPEP 706.02(j). For the reasons presented above, neither Esposito nor Wiecha, taken alone or in permissible combination, teach these limitations of claim 50, as well as the remaining independent claims.

In addition, Applicants also respectfully submit that the Office Action fails to satisfy the burden of factually supporting the alleged motivation to combine the two references. The duty of factually supporting the alleged motivation to combine may not be satisfied by engaging in hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. Evidence must therefore be provided to suggest the combination, and, as will be appreciated, "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Office Action's failure to

meet this criteria is particularly evident with regard to the dependent claims, wherein neither reference is cited as teaching any recited limitation, nor is Official Notice taken thereof (which, Applicants maintain, would be inappropriate in any event).

In this regard, Applicants respectfully submit that Esposito and Wiecha, taken alone or in permissible combination, are not capable of presenting a system in which the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option, exist. Such technology is simply not shown, taught or suggested by either of these references. For the claimed invention, the ability to process complex orders in the manner discussed in the specification and recited in the claims, the combination of the use of Esposito and Wiecha is inadequate, particularly given that such is achieved through the invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option.

This leads to the conclusion that not only do Esposito and Wiecha fail to show, teach or suggest such technology, but have no need to do so, because neither recognizes these benefits. Failing to appreciate these benefits, neither reference addresses the obstacles that exist to creating solutions, nor providing any such solutions, such as those provided by the claimed invention. Lacking such appreciation and teachings, one of skill in the art could not find any motivation to combine their disclosures, because neither could be seen as lacking in this regard. Save for having the present disclosure to use as a blueprint, and so implying the use of hindsight, an obviously impermissible approach, which need not be dealt with here, the proposed combination is without motivation and support.

Further, the Office Action does not establish that such a combination of the teachings of these references would meet with success, as required. This comes as no surprise, as there is no way to combine these references to achieve the claimed invention, as demonstrated by the foregoing. Moreover, there is no teaching in the references, nor any extant in the skill in the art, which would provide the teachings necessary to successfully combine the disclosures of Esposito and Wiecha. Certainly, each of

Esposito and Wiecha is directed to its own solution to its own problems, and is a self-sufficient and self-contained solution in that regard.

Were one of skill in the art to proceed, notwithstanding these and the other infirmities extant in such a combination, (a fruitless effort and one which Applicants do not concede in any event), the combination would still fail to teach the claimed invention, if only in regard to the claimed invocation of a workflow process and, subsequently, a business service method, and so the performance of a function associated with a selected option. At best, such a combination would yield a system for ordering items over computer network using an electronic catalog, which would provide such services using real time electronic commerce. Thus, the claimed invention, by its recognition of the need for complex order processing, is in no way made obvious (nor anticipated) by Esposito and/or Wiecha, taken alone or in any permissible combination.

For at least the foregoing reasons, Applicants respectfully request the Examiner's reconsideration and withdrawal of the rejections to claims 1, 19, and 50, as well as all claims dependent therefrom, and an indication of the allowability of same.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicants hereby petition for such extensions. Applicants also hereby authorize that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to Deposit Account 502306.

Respectfully submitted,

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